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| 09/922,555 | 08/03/2001 | Michael J. O'Neill | 2507/101 | 9456 |

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| EXAMINER |
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WOO, JULIAN W

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| ART UNIT | PAPER NUMBER |
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3731

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,555

Applicant(s)

O'NEILL, MICHAEL J.

Examiner

Julian W. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/22/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-17 and 33-38 is/are allowed.
- 6) ☒ Claim(s) 18-32 and 39-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. Claims 18-32 and 39-44 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005), *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the patented file (09/221,240), original claim 10, which cited "a generally cylindrical, hollow, open-ended, forked cannula concentrically over said dilator," was objected to as being in dependent form but containing allowable subject matter. In response, applicant amended independent apparatus claim 8 to include the subject matter of claim 9 (from which claim 10 depended) and

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claim 10. Claim 8 was allowed. However, in the reissue application, base apparatus claims 18, 26, 31, and 39 do not cite a cannula or the allowable subject matter of original claim 10 in the patented file. Thus, claims 18-32 and 39-44 have been rejected based upon recapture.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 26-29, 39, and 41-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Farr et al. (4,895,166). Farr et al. disclose, at least in figures 5-9 and in col. 3, lines 42-45, an apparatus usable for bone harvesting or coring device, where the apparatus includes a collection shaft (26) or a hollow cylindrical shaft, a stainless steel cutting tip comprising openings, two protruding blades (32) joined at one end, and two downward facing cutting edges (at 38, 40 as seen in fig. 6) extending in a circumferential circle with respect to a circle in a plane perpendicular to the shaft's longitudinal axis, where each protruding blade includes counterclockwise and clockwise cutting edges and is at a 45 deg. angle to the shaft's longitudinal axis. Also with respect to claims 27-29 and 42-44,

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whether product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. That is, claims 27-29 and 42-44 are not construed as being limited to the product formed by the processes recited.

4. Claims 31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Fox (6,071,284). Fox discloses, at least in figures 4a and 5a and in col. 11, lines 50-56 and col. 12, lines 55-61, a bone harvesting apparatus including a cutter device having a depth gage (at 240) at the proximal end of a collection shaft (110) and calibration marks (105) at the distal end of the collection shaft that indicate a volume of bone harvested, where the depth gage is readable when the cutter device is inserted into a dilation channel.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farr et al. (4,895,166) in view of Fox (6,071,284). Farr et al. disclose the invention substantially as claimed, but do not disclose that collection shaft comprises a biocompatible polycarbonate material. Fox teaches, in col. 11, lines 1-16, polycarbonate material, among other materials, for use in the collection shaft of Fox's device. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Fox, to modify the collection shaft of the device of Farr et al., so that it comprises a biocompatible polycarbonate material. Such a material is strong, lightweight, and easily formed, and it can be rendered transparent or translucent for viewing of harvested bone.

Allowable Subject Matter

7. Claims 1-17 and 33-38 allowed.

Response to Amendment

8. See the new grounds of rejection above.

The amendment is in an improper format. Applicant is reminded that any future amendments submitted in a reissue application must comply with 37 CFR 1.173(b). In summary, an amendment to claims must be in the following format:

(a) An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each changed patent claim and each added claim must include

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markings pursuant to paragraph (c) below, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(b) Status of claims and support for claim changes . Whenever there is an amendment to the claims, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(c) Changes shown by markings . Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

(d) Numbering of patent claims preserved. Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Douvas et al. (3,990,453) and Farr (5,019,088) teach devices with protruding blades and openings.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julian W. Woo
Primary Examiner

June 9, 2006